

REMARKS

In the last Office Action,¹ the Examiner rejected claims 1-3, 7-15, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,715,403 to Stefik ("Stefik") in view of U.S. Patent Application Publication No. 2002/0002524 to Kossoovsky et al. ("Kossoovsky").

By this amendment, Applicant has amended claims 1, 14, and 19. Claims 1-3, 7-9, 11-15, 17, 19, and 20 are currently pending. Of these, claims 1, 14, and 19 are independent.

A. Substantive Issues

Applicant respectfully traverses the rejection of claims 1-3, 7-9, 11-15, 17, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Stefik in view of Kossoovsky.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th ed., rev. 2, May 2004). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

must “be found in the prior art, not in applicant's disclosure.” See M.P.E.P. § 2143 (8th ed., rev. 2, May 2004).

No *prima facie* case of obviousness exists with respect to claims 1-3, 7-9, 11-15, 17, 19, and 20 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For example, amended claim 1 recites an electronic appliance comprising, among other things:

a re-writable memory section for recording information regarding a patent relating to a technology adopted in the electronic appliance . . .

a control section to . . . select the appropriate current data to be output in accordance with a sales condition recorded in the re-writable memory section . . .

Stefik discloses a system for controlling use and distribution of digital works by allowing the owner of a *digital work* to attach *usage rights* to their work. See Stefik, Abstract. Usage rights, as defined by Stefik, are “a language for defining the manner in which a digital work may be used or distributed, as well as any conditions on which use or distribution is premised.” See Stefik, col. 52, lines 4-7. For example, printing or copying a digital work corresponds to a specific usage right. See Stefik, col. 7, lines 30-35. In contrast, “a patent relating to a technology adopted in the electronic appliance” is not a usage right, as defined by Stefik.

In addition, the Examiner alleged that by disclosing a computer and computer network, Stefik “clearly discloses the input, output, display, printing, control, memory, re-writable memory and communication functions as claimed by the Applicant.” See Office Action, page 4. Applicant respectfully disagrees and submits that the conclusion drawn by the Examiner does not logically follow from the premise. A computer and/or computer network capable of controlling use and distribution of digital works does not necessarily include “a control section to . . . select the appropriate current data to be output in accordance with a sales condition recorded in the re-writable memory section,” as claimed. In fact, Stefik does not disclose anywhere “a *sales condition* recorded in the re-writable memory section” nor “a control section . . . [that] select[s] the appropriate current data to be output in accordance with a sales condition,” as recited in claim 1.

The Examiner also alleged that Stefik discloses updating and renewing digital rights information. However, a computer that updates and renews digital rights information does not constitute “a control section to . . . select the appropriate current data to be output in accordance with a sales condition recorded in the re-writable memory section,” as claimed.

The Examiner relied on Kossovsky for its disclosure of a relationship between intellectual property rights and patent rights. See Office Action, page 4. However, Kossovsky does not remedy the deficiencies of Stefik identified above. For example, although Kossovsky describes a system for exchanging patents online, such a system does not constitute an electronic appliance comprising “a re-writable memory section for

recording information regarding a patent *relating to a technology adopted in the electronic appliance.*"

Accordingly, the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn. Amended claims 14 and 19, although of different scope, both recite elements similar to those of claim 1 discussed above. Therefore, claims 14 and 19 are allowable over the combination of Stefik and Kossovsky for at least reasons discussed above with respect to claim 1. In addition, claims 2-3, 7-9, 11-13, 15, 17, and 20 depend from and add additional features to independent claims 1, 14, and 19. Accordingly, these claims are allowable at least by virtue of their dependence on allowable claims 1, 14, and 19.

B. Procedural Issues

The M.P.E.P. requires that all actions on the merits issued by an Examiner "be complete and clear as to all matters." 37 C.F.R. § 1.104(b). See also M.P.E.P. § 707.07. Specifically, 37 C.F.R. § 1.104(c)(2) provides that

"[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best reference at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference . . . must be clearly explained . . ."

See also M.P.E.P. § 707 (emphasis added).

The Examiner observed that Stefik does not disclose the invention claimed by Applicant. See Office Action, page 4, (observing that Stefik's disclosure does not extend to patent rights). Therefore, Stefik "shows or describes inventions other than that claimed by the applicant." However, Applicant respectfully submits that the

Examiner neither designated particular parts of Stefik nor clearly explained the pertinence of Stefik in rejecting the claims, as required by 37 C.F.R. § 1.104(c)(2). Instead, the Examiner did little more than quote the abstract of Stefik and allege that "Stefik, by disclosing a computer and computer network clearly discloses the input, output, display, printing, control, memory, re-writable memory and communication functions as claimed by the Applicant." See Office Action, pages 3 and 4.

Therefore, should the Examiner continue to rely on Stefik in rejecting Applicant's claims, Applicant respectfully requests that the Examiner designate particular parts relied on as nearly as practicable and clearly explain the pertinence of Stefik, as required by 37 C.F.R. § 1.104(c)(2).

Conclusion

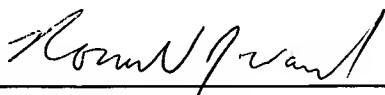
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 10, 2006

By: 

Ronald J. Ward
Reg. No. 54,870